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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,501	03/07/2002	Vladimir Kliatzkin	468/1	7024

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EXAMINER

ALEJANDRO, RAYMOND

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/070,501

Applicant(s)

KLIATZKIN, VLADIMIR

Examiner

Raymond Alejandro

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 28-46.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see next page.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

**RAYMOND ALEJANDRO
PRIMARY EXAMINER**

Raymond Alejandro
Primary Examiner
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Response to Arguments

1. Applicant's arguments filed 04/04/06 have been fully considered but they are not persuasive.

2. The gist of applicant's arguments centers on the assertion that independent claim 28 does require certain features such as: *a) being a battery of a Silver-Zinc system; b) compacted "granules" of powder; c) metallic casing filled with an electrolyte; d) electrodes are flat or spiral; e) "without sintering or gluing particles"; f) this elastic means is "a spring"; g) the separator is made of cellophane; h) "claim 28 does not mention features, which are present in Yardney, like the partition, for example. Claim 28 neither mentions a partition, nor pressure exerting means inserted in the casing and capable of exerting pressure on one side of the partition"; i) the electrodes of the invention become slurry when immersed in the electrolyte.* In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *all of the features above, see item a to i*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note that applicant's arguments are not commensurate in scope with the limitations/recitation of independent claim 28. That is to say, applicant is conveniently arguing the lack of certain features or limitations which are not positively recited in independent claim 28 so as to either positively include or positively exclude them. Applicant's characterization of the subject matter of independent claim 28 does not circumscribe or is way out of proportion, by far, of the scope of presently claimed invention of claim 28.

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3. Applicant has argued that the invention as claimed requires “*elastic means applying pressure on each of said electrodes during charging and discharging of said cell*”. Concerning this matter, the examiner avers that casing 30 of Yardney performs exactly the same function, structurally and mechanically, of applicant’s elastic means. Furthermore, on page 8, 1st full paragraph and page 9, 1st full paragraph of the amendment dated 04/04/06, applicant discusses that “*The elastic walls of the cell are adapting themselves to the periodical volume changes and ensure that during charging and discharging there is always a required contact being maintained in order to provide the contact therebetween*”. Therefore, applicant admits on the record that by “elastic means” he means “the cell walls” or “the cell container or casing”. Accordingly, the examiner wishes to point out that Yardney’s casing performs exactly the identical function specified in the instant claim in substantially the same way, and produces substantially the same results as the claimed elastic means of the present invention.

4. As to applicant’s arguments that “*the (Yardney’s) casing per se does not act as the specific pressure applying means and Yardney’s casing does not exhibit any degree of elasticity*” because it is apparently “*rigid*”, it is noted that the present claims fail to positively stipulate the degree of elasticity. Elasticity is a quantifiable characteristic. As such, if an article or feature does have a degree of elasticity near 0, it does certainly exhibit elasticity but at a lower level. Hence, a rigid body does exhibit a low degree of elasticity. Therefore, it is contended that although Yardney’s casing may be rigid, such a casing is capable of exhibit a low degree of elasticity.

5. In response to applicant’s arguments that: a) the electrodes are not made out of a “sintered or glued material” (without sintering or gluing of the particles); b) “claim 28 does not

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mention features, which are present in Yardney, like the partition, for example. Claim 28 neither mentions a partition, nor pressure exerting means inserted in the casing and capable of exerting pressure on one side of the partition”; c) “the electrodes of the invention are not monolithic”; and d) “Yardney necessitates using additional elements (partition, spring, stationary plate)”, the examiner points out that the transitional phrase “comprising” recited in the instant claims is an open-ended clause, and does not exclude the inclusion of additional features. The transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004). Thus, applicant’s arguments have little merit.

6. In response to applicant's argument that: a) “*The embodiment in which the cell walls serve as a means for applying pressure has an advantage, since this arrangement does not require a dedicated spring means to be placed within the cell*”, or b) “*The object of Yardney is quite different. Yardney seeks to compensate for the reducing of pressure associated with swelling of the separator due to a change of the pressure-versus-thickness ratio*”, the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

7. In response to applicant's argument that there is no suggestion to combine the references or that the secondary references (*Devit '746*, *Dews et al '538*, *Ruetschi '914*, *Ferrando '349*, *Ferrando '138*, *Mansfield Jr et al '580* and the *WO '689-Pauling*) are not combinable with the primary reference (*Yardney '376*), the examiner recognizes that obviousness can only be

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established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

(Emphasis supplied→) Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *The burden is thus shifted to the applicant to provide or supply sound or objective evidence to demonstrate that any of the applied teachings of Devit '746, Dews et al '538, Ruetschi '914, Ferrando '349, Ferrando '138, Mansfield Jr et al '580 and the WO '689-Pauling, when used in Yardney '376, does cause deleterious or detrimental effects thereto. Since PTO does not have proper equipment to perform analytical or mechanical test, that burden is then shifted to the applicant.*


Accordingly, the examiner also asserts that it is not enough that applicant's representative personally believes that the prior art (the applied references) cannot be combined together or that the combined prior art cannot function together. That is to say, the arguments of counsel cannot take the place of evidence in the record. An assertion of what seems to follow from common

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experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of inherent anticipation/obviousness (See *MPEP 716.01 and 2145:*

Consideration of Applicant's Rebuttal Arguments).

8. Last but not least, in response to applicant's arguments that "*it is improper under the PTO rules for the Examiner to do a new search each time applicant overcome a prior art rejection*" and that "*In the Final Rejection a new prior art reference is cited improperly as it was not necessitated by the amendment to the claims*". Applicant is reminded that the amendment dated 11/02/05 did, in fact, amend the present claims. That is to say, the scope of the claims was changed or modified by the amendment filed therein. As such and in view of that amendment amending the claims, the examiner did what is set forth in the MPEP guidelines. It is unfair that applicant does keep amending the claims as applicant has done throughout the prosecution, and at the same time, does expect that the examiner does not perform his basic duties or update the search. It is respectfully submitted that if applicant wanted to claim a specific invention originally, applicant should have done that since the very beginning of the prosecution. Accordingly, the examiner has done nothing more nothing less [*sic*] than to fairly respond to applicant's communications which have included substantial amendments to the scope of the instant claims.


RAYMOND ALEJANDRO
PRIMARY EXAMINER